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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/161,283	09/28/1998	TOMOHIRO MAEKAWA	PMS255979	7428

7590 04/05/2004

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CHICAGO, IL 60603-3406

EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/161,283

**Applicant(s)**

MAEKAWA, TOMOHIRO

**Examiner**

Kevin R Kruer

**Art Unit**

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,8-12 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,5,8-12 and 15-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 5, 8-12, and 15-23 have rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original disclosure for the limitation "wherein the resin layer (A) has no insoluble methyl methacrylate particles." The examiner reminds Applicant that the mere absence of a positive recitation is not basis for an exclusion. The examiner takes the position that the original disclosure contains neither explicit nor implicit support for such a limitation. Applicant must point out where there is support in the original disclosure for said negative limitation or amend the claim to overcome the rejection.

3. Claims 1, 2, 5, 8-12, and 15-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to read on methacrylate particles having "uniform composition." The

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examiner takes the position that the original disclosure contains neither explicit nor implicit support for such a limitation. Applicant must point out where there is support in the original disclosure for said negative limitation or amend the claim to overcome the rejection.

***Claim Rejections - 35 USC § 103***

4. The rejection of claims 1, 2, 5, 8-12, and 15-23 under 35 U.S.C. 103(a) as being unpatentable over JP 55-034924A (herein referred to as Toyooka) in view of WO97/30117 (Tadokoro) and Koizumi et al (US 6,309,739) or Toritani et al (US 5,169,903) has been overcome by amendment.

***Response to Arguments***

Applicant's arguments filed November 4, 2003 have been fully considered but they are not persuasive.

Applicant argues that Examples 1-6 support the exclusion of methacrylate particles in the core layer because the examples are silent to the core comprising insoluble methyl methacrylate particles. The examiner respectfully disagrees. It is not explicitly stated anywhere in the original disclosure that the core should not comprise methacrylate particles. Furthermore, the components utilized in the core composition of the examples do not add up to 100 parts. Thus, the examples fail to even imply that the core does not comprise methacrylate particles. The fact that the examples are silent to a teaching with regard to methacrylate particles in the core is not basis for an exclusion

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(see MPEP 2173.05(i)). The examples are silent to core comprising millions of possible components, including methacrylate particles. Thus, the examples contain no more support for excluding the methacrylate particles than they do for excluding any other unnamed component. Thus, the rejection is maintained.

The examiner notes that the term "uniform composition" has been understood to read on a particles with no variation in their composition. Thus, all the particles present must have exactly the same percentage of copolymers, the same crosslink density, the same distribution of copolymer, the same molecular weight, etc.

Applicant argues that the limitation "uniform composition" is supported by the disclosed methods of making the particles in the specification. However, the teachings in the specification do not agree in scope with the present claim language. Specifically, the disclosed method of making does not describe how to obtain particles with "uniform composition." Furthermore, the claim language would allow for particles with monomeric compositions outside of the scope disclosed in the specification.

Applicant's arguments with respect to the prior art rejection are moot since the rejection has been overcome by amendment.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,216,096 and US 5,458,975 each teach compositions containing crosslinked polymethyl methacrylate particles.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

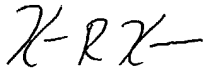
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer  
Patent Examiner-Art Unit 1773



Paul Thibodeau  
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